

### **REMARKS**

The examiner is thanked for a thorough examination of the present patent application.

Claims 1–19 were submitted with the application. Claims 12–19 were previously withdrawn. Claims 1-11 were rejected.

In this document, the term “applicant” is used generically to indicate and include both singular “applicant” and plural “applicants.”

#### **I. IN THE TITLE**

The Title was objected to. The Title is currently amended overcoming the objection.

#### **II. IN THE DRAWINGS**

The drawings were “objected to because in Figures 1 and 2, legend designation that it is “prior art” is missing.

REPLACEMENT SHEET 1/2 is submitted herewith including the recommended change to Figures 1 and 2 legends.

The drawings were objected to because the drawings allegedly fail to illustrate caulking agent that caulks the inner surface of the gasket. The applicant respectfully traverses. Figures 3A, 3B, and 3C illustrate caulking agent 36 on both the inner surface and the outer surface of the gasket.

#### **III. CLAIM REJECTIONS**

Claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by Goldmann et al. (U.S. Patent No. 6,459,160). The applicant respectfully traverses. Nonetheless, the applicant currently amends, without prejudice, Claim 1 to recite the present invention with even more clarity.

“A claim is anticipated only if **each and every element** as set forth in the claim is found ... in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, USQP2D 1051 (Fed. Cir. 1987) (Emphasis added). In fact, for a valid rejection under 35 U.S.C. 102(b), “[t]he **identical invention** must be shown in as **complete detail** as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989) (Emphasis added). Moreover, “**All words** in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494 (CCPA 1970) (Emphasis added).

Further, “it is fundamental that **claims are to be construed in light of the specifications** and both are to be read with a view to ascertaining the invention.” E.g., *Adams v. United States*, 383 U.S. 39, 49 (1966). “**Where an explicit definition is provided by the applicant for a term, that definition will control interpretation** of the term as it is used in the claim.” MPEP 2106 citing *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings.”); see, also, *In re Vogel*, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970).

Here, Claim 1, currently amended, recites bonding agent and a separate caulking agent, each having the specified structure. The applicant respectfully submits that the limitations of Claim 1, currently amended, are not anticipated by the Goldman reference. For example, the Goldman reference does not anticipate the separate bonding agent and caulking agent in the structure recited in Claim 1.

Claims 2, 3, 5, 6, 9 and 10 were rejected under 35 U.S.C. 102(b) as being

anticipated by the Goldmann reference. The applicant respectfully traverses. The applicant respectfully traverses the rejection. Claims 2, 3, 5, 6, 9 and 10 were depend, directly or ultimately, from Independent Claim 1, currently amended. As discussed above, Claim 1, currently amended, is not anticipated by the cited prior art reference. Accordingly, the applicant respectfully submits that Claims 2, 3, 5, 6, 9 and 10 are allowable for at least the same reasons for which Claim 1 is allowable. See, e.g., *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Further, Claims 5 and 6 are currently amended to recite the present invention with even more clarity. The applicant respectfully submits that Claims 5 and 6, currently amended, are even more allowable over the cited reference.

Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over the Goldmann reference in view of Kikushima et al. (U.S. Publication No. 2003/0061693). The applicant respectfully traverses.

For a valid rejection under 35 U.S.C. 103(a), “[t]he **examiner bears the initial burden** of factually supporting any *prima facie* conclusion of obviousness.” MPEP Ed. 8 Rev. 2, Sec. 2142 (italic in the original; bold added). “The PTO bears the burden of establishing a case of *prima facie* obviousness.” *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966),

“To establish a *prima facie* case of obviousness, three basic criteria must be met. **First**, there **must** be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there **must** be a reasonable expectation of success. **Finally**, the prior art reference (or references when combined) **must** teach or suggest all the claim limitations.” MPEP Ed. 8 Rev. 2, Sec. 2142 (italic in the original; bold added), citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Further, “[t]he teaching or suggestion to make the claimed combination and the

reasonable expectation of success **must both be found in the prior art**, and not based on applicant's disclosure." *Id.* (bold added). In fact, "The mere fact that reference can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests** the desirability of the combination." MPEP Ed. 8 Rev. 2, Sec. 2143.01 (underline in the original, bold added), citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Again, there must be a suggestion or motivation **in the reference** to do so." *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432 (emphasis added).

Claim 4 depends from Independent Claim 1, currently amended. As discussed above, Claim 1, currently amended, is not anticipated by the cited prior art reference. Accordingly, even if the Kikushima reference were combined with the Goldmann reference, it fails to teach or suggest all the claimed limitations. Consequently, the applicant respectfully submits that Claim 4 is allowable over any combination of the cited references.

Claims 7 and 8 were<sup>1</sup> rejected under 35 U.S.C. 103(a) as being unpatentable over the Goldmann reference in view of Eberhard et al. (U.S. Patent No. 6,770,885). The applicant respectfully traverses. Claims 7 and 8 depend from Independent Claim 1, currently amended. As discussed above, Claim 1, currently amended, is not anticipated by the cited prior art reference. Accordingly, even if the Eberhard reference were combined with the Goldmann reference, it fails to teach or suggest all the claimed limitations. Consequently, the applicant respectfully submits that Claims 7 and 8 are allowable over any combination of the cited references. Further, Claims 7 and 8 are currently amended to recite the present invention with even more clarity. The applicant respectfully submits that Claims 7 and 8, currently amended, are even more allowable over the cited reference.

Claim 11 was rejected under 35 U.S.C. 103(a) as being unpatentable over the Goldmann reference in view of McHerron et al. (U.S. Patent No. 6,046,074). The applicant respectfully traverses. Claim 11 depends from Independent Claim 1, currently amended. As discussed above, Claim 1, currently amended, is not anticipated by the cited prior art

reference. Accordingly, even if the McHerron reference were combined with the Goldmann reference, it fails to teach or suggest all the claimed limitations. Consequently, the applicant respectfully submits that Claim 11 is allowable over any combination of the cited references. Further, Claims Claim 11 is currently amended to recite the present invention with even more clarity.


Claims 12 – 19 were previously withdrawn.

Claims 20 – 23 are added herein as new claims, these claims depending from Claim 1 and reciting additional aspects of the present invention.

### **CONCLUSION**

In view of the foregoing Remarks, the applicant respectfully submits that the entire application is in condition for allowance. The applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



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